

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GRIT ENERGY SOLUTIONS, LLC,
Petitioner

v.

OREN TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2017-00768
Patent 8,585,341 B1

JOINT BRIEF ON REMAND

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I. Introduction

In *Grit Energy Solutions, LLC, v. Oren Technologies, LLC*, 957 F.3d 1309 (Fed. Cir. 2020) (the “Remand Decision”), the Court of Appeals for the Federal Circuit (the “Federal Circuit”) “conclude[d] that Constantin does disclose the ’341 configuration [as defined in the Remand Decision]” and “vacate[d] and remand[ed] for the Board to reconsider Grit Energy’s obviousness arguments[, s]ome of [which] relied on Constantin as the primary prior art reference, and others relied on Eng Soon as the primary prior art reference.” 957 F.3d at 1323. The Remand Decision then addressed reasons the Board gave for rejecting Grit Energy’s obviousness arguments. *Id.* at 1323-24.

Pursuant to the Board’s July 24, 2020 order (Paper 31), the parties jointly submit this paper to identify where in the briefing and the hearing transcript¹ the parties addressed issues raised in the Remand Decision.

II. Grit Energy’s Obviousness Arguments

A. Constantin as the Primary Reference

The parties identify the following locations in the briefing and the hearing transcript for their arguments and evidence addressing whether the challenged claims are unpatentable as obvious with Constantin as the primary reference:

¹ The parties received permission via e-mail from the Board on August 28, 2020, to identify locations in the hearing transcript.

For Petitioner:

- Petition (Paper 2) sections IV.B (page 6), IX.A.3 – IX.A.4 (pages 39-52), IX.A.6 – IX.A.7 (pages 56-57), IX.A.7.(a)(2) (pages 60-61), IX.A.7.(b) – IX.A.7.(d) (pages 61-64), and IX.B (pages 64-77).
- Reply (Paper 17) sections VI – VII (pages 22-23).
- Petitioner’s Rehearing Request (Paper 28) sections I (page 2) and IV (pages 13-15).

For Patent Owner:

- Patent Owner Response (Paper 15) sections IV.B (pages 27-28), VI (pages 29-30), and VI.E – VI.F (pages 56-61).

B. Eng Soon as the Primary Reference

The parties identify the following locations in the briefing and the hearing transcript for their arguments and evidence addressing whether the challenged claims are unpatentable as obvious with Eng Soon as the primary reference:

For Petitioner:

- Petition sections IV.B (page 6), IX.A (pages 20-21), IX.A.1 – IX.A.2 (pages 21-39), IX.A.5 (pages 52-55), IX.A.7 (page 57), IX.A.7.(a)(1) (pages 58-60), IX.A.7.(2)(b) – IX.A.7.(2)(d) (pages 61-64), and IX.B (pages 64-77).
- Reply sections I (page 1), III (pages 3-11), IV (page 11), IV.C (pages 17-19), and V – VII (pages 19-23).
- Hearing Transcript (Paper 26) at:
 - page 4, line 9 – page 6, line 26,
 - page 16, line 13 – page 18, line 3, and
 - page 39, line 14 – page 45, line 18.
- Petitioner’s Rehearing Request (Paper 28) sections I (pages 1-2), II (pages 2-5), III.B (pages 11-13), and IV (pages 13-15).

For Patent Owner:

- Patent Owner Response sections IV.A (pages 26-27), VI (pages 29-30), VI.A – VI.B (pages 30-38), VI.C.3 (pages 43-46), and VI.D – VI.F

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